

REMARKS

The Applicant thanks the Examiner for the careful attention given the application.

Claims 22-24 of the present application are currently pending. Claims 22-24 stand rejected. For the reason set forth below, the Applicant respectfully traverses the rejections and submits that all pending claims are in condition for allowance and allowance of the application is respectfully requested.

In the Office Action, the Examiner rejected claims 22-24 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,834,999, issued to Kinman (hereinafter Kinman '999) or United States Patent No. 5,811,710, issued to Blucher et al. (hereinafter Blucher) in view of United States Patent No. 5,168,117, issued to Anderson (hereinafter Anderson).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. (see MPEP §2143.03). The motivation to combine or modify a reference in order to make a rejection must be found within the prior art and not based on applicant's disclosure.

The Office Action correctly acknowledges that neither Kinman '999 nor Blucher disclose a completely flat ferromagnetic plate. In fact, Kinman '999 and Blucher teach directly away from the pickup device of the present application. Specifically, Kinman '999 and Blucher both include shields having a wall extending therefrom that shields the coil, divides and manipulates the magnetic field emanating from the magnetic poles (Kinman '999 Fig. 1:34-39, Col. 3:39-42; Blucher Fig. 1:11; Col. 4:25-36) into two sections (as shown in Blucher Figs. 2 and 4). Thus, both Kinman and Blucher teach away from the use of the flat plate recited in claim 22 of the present application.

Anderson utilizes a bar magnet 20 disposed between the two coils (Fig. 2:20. Col. 3:36-41) as opposed to magnetic pole pieces utilized in Kinman '999 and Blucher.

The bar magnet 20 is used for an entirely different purpose than the shield utilized in both Kinman and Blucher.

Applicant respectfully submits that the Examiner has failed to provide a motivation to combine or modify a reference in order to make the rejection as required by MPEP §2143.03. No motivation to combine the references can be found in the references themselves as required by MPEP §2143.03. Rather, the Applicant submits that the references teach away from their combination. Kinman '999 and Blucher teach away from Anderson by requiring shields having walls extending therefrom. Further, there is no motivation to substitute the bar magnet 20 of Anderson with the shield of Kinman '999 and Blucher as the bar magnet lacks the shielding walls required by both Kinman '999 and Blucher. Still further, there is no motivation to even use the bar magnet of Anderson as the magnetic element of the Kinman '999 and Blucher pick ups is provided by the magnetic poles.

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable United States Patent No. 5,668,520, issued to Kinman (hereinafter Kinman '520) or unpatentable United States Patent No. 6,103,966, issued to Kinman (hereinafter Kinman '966) in view of Anderson. The Applicant respectfully submits that for at least the same reasons as stated above claim 22 is patentable over Kinman '520 or Kinman '966 in combination with Anderson.

Claims 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,834,999, issued to Kinman (hereinafter Kinman '999) or United States Patent No. 5,811,710, issued to Blucher et al. (hereinafter Blucher) in view of United States Patent No. 3,657,461, issued to Freeman (hereinafter Freeman). As stated above, Kinman '999 and Blucher both include shields having a wall extending therefrom that divide the magnetic field into two sections rather than the flat plate recited in claim 22 of the present application. Like Anderson, Freeman recites a pickup having a flat magnetic divider plate 20 positioned between two coils. For at least the reasons stated above, the Applicant respectfully submits that Freeman teaches away from a ferromagnetic plate positioned therebetween. In addition, the Applicant respectfully submits that the Examiner has failed to provide a motivation to combine or

modify Kinman '999 or Blucher with Freeman in order to make the rejection as required by MPEP §2143.03.

Applicant respectfully submits that the Examiner has used impermissible hindsight to recreate the Applicant's invention. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 47 USPQ2d 1453 (Fed. Cir.1998) "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentabilitythe essence of hindsight." In re Dembicza, 50 USPQ2d 1614 (Fed. Cir.1999) The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Thus, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In view of the foregoing, Applicant believes the pending claims to be in condition for allowance. Reconsideration and early allowance are respectfully and sincerely solicited.

It is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned attorney at the below listed telephone number.

Serial No. 09/825,918
Am dt dated January 20, 2004
Reply to Office Action of September 26, 2003

Patent
12017-0024

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to Deposit Account No.: 50-1329.

Respectfully submitted,

Dated: 1/29/04



Jan P. Weir, Reg. No. 43,253
Attorney for Applicant

STRADLING YOCCA CARLSON & RAUTH
660 Newport Center Drive, Suite 1600
Newport Beach, CA 92660
Telephone: 949.725.4196
Facsimile: 949.823.5196

Customer Number: 31,278